

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): Califano et al.
Docket No.: YOR920000687US2
Serial No.: 09/841,580
Filed: April 24, 2001
Group: 1631
Examiner: Lori A. Clow

I hereby certify that this paper is being deposited on this date with the U.S. Postal Service as first class mail addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Signature: *Uma Maurer* Date: October 20, 2003

Title: Characterization of Phenotypes by Gene Expression Patterns and Classification of Samples Based Thereon

TRANSMITTAL LETTER

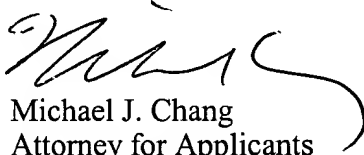
Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is a Response to a Restriction Requirement relating to the above-identified patent application. There is no additional claim fee due in connection with the Response.

In the event of non-payment or improper payment of a required fee, the Commissioner is authorized to charge or to credit **IBM Corporation Deposit Account No. 50-0510** as required to correct the error. Duplicate copies of this letter are enclosed.

Respectfully submitted,


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Date: October 20, 2003



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5 **Patent Application**

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RESPONSE TO RESTRICTION REQUIREMENT

20 Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

25 Sir:

This is in response to the outstanding Office Action dated October 3, 2003 in the above-identified application. Claims 1-28 are currently pending in the application.

In the outstanding Office Action, the Examiner required restriction of the application to
30 one of the following two groups of claims: Group I, including claims 1-3, 17-19 and 23-25; and Group II, including claims 4-16, 20-22 and 26-28.

Applicants respectfully assert that the restriction requirement is improper and should be withdrawn, since each Group is generally related to techniques for the characterization of phenotypes, and it is believed that a complete search for each Group would require a search of
35 most, if not all, of the individual classes and subclasses. Accordingly, Applicants submit that an examination of both Groups would not impose a serious burden on the Examiner. Where, as here, "the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." MPEP §803.

Accordingly, it is respectfully requested that the restriction requirement be reconsidered and withdrawn and that all of the pending claims in the application be examined together in this application, or alternatively, Applicants hereby elect Group I, that is, claims 1-3, 17-19 and 23-25, with traverse, for prosecution in this application.

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Date: October 20, 2003

10

Respectfully submitted,



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